

IN RESPONSE TO THE OFFICE ACTION:**OBJECTIONS UNDER 37 CFR 1.75(C)**

The objections of claims 4-8 have been obviated by amending the claims such that no multiple dependent claim depends on another multiple dependent claim. Claim 1 has been amended to remove the term "having possessing."

REJECTION UNDER 35 U.S.C. § 112

The rejections of claims 2 and 3 under §112 have been obviated by the amendments changing "selected from the class including" to "selected from the group consisting of" as per the Examiner's suggestion.

FIRST REJECTION UNDER 35 U.S.C. § 102:

Claims 1-3 have been rejected under 35 U.S.C. §102(b) as allegedly being anticipated by US 4,618,434 (Blouin). Applicants respectfully traverse the rejection and ask the Examiner's reconsideration in view of the following:

For there to be anticipation under 35 U.S.C. §102, "each and every element" of the claimed invention must be found either expressly or inherently described in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) and references cited therein. See also *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 1571, 230 USPQ 81, 84 (Fed. Cir. 1986) ("absence from the reference of any claimed element negates anticipation."); *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). As pointed out by the court, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). An anticipating reference must describe the patented subject matter with sufficient clarity and detail to establish that the subject matter existed and that its existence was recognized by persons of ordinary skill in the field of the invention. *ATD Crop. V. Lydall, Inc.*, 159 F.3d 534, 545, 48 USPQ 2d 1321, 1328 (Fed. Cir. 1998). See also *In re Spada*, 911 F.2d 705, 708, 15 USPQ 2d 1655, 1657 (Fed. Cir. 1990).

Independent claim 1 has been amended to specify that the particulate material is substantially water non-soluble and degrades in acidic conditions. Because these limitations are absent from Blouin, the present application is not anticipated by Blouin.

Given the above, Applicants respectfully request that the Examiner indicate the allowance of claims 1-3 in the next paper from the Office.

SECOND REJECTION UNDER 35 U.S.C. § 102:

Claims 1-3 have been rejected under 35 U.S.C. §102(b) as allegedly being anticipated by US 4,473,480 (Green). Applicants respectfully traverse the rejection and ask the Examiner's reconsideration in view of the following:

Applicants have set forth the applicable case law above in response to the first rejection under 35 U.S.C. §102(b). In the interest of brevity, Applicants request the Examiner to refer to this discussion and expressly incorporate the contents by reference.

Independent claim 1 has been amended to specify that the particulate material degrades in acidic conditions. In contrast, Green specifies that the aqueous system should have an alkaline pH of at least 8. (See Column 6, lines 31-34). Thus, because this limitation is absent from Green, claims 1-3 are not anticipated by Green.

Given the above, Applicants respectfully request that the Examiner indicate the allowance of claims 1-3 in the next paper from the Office.

Applicants hereby request for any extension of time that may be deemed necessary to further the prosecution of this application.

The undersigned representative hereby authorizes the Commissioner to charge any additional fees which may be required, or credit any overpayment, to Deposit Account No. 01-2508, referencing Order No. 11836.0695.PCUS00.

In order to facilitate the resolution of any issues or questions presented by this paper, Applicants respectfully request that the Examiner directly contact the undersigned by phone to further the discussion, reconsideration and allowance of the claims.

Respectfully submitted,



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Date: Feb 5, 03



Applicant: SAWDON, Christopher et al.
Application No.: 09/762,035

Examiner: P. Tucker
Art Unit: 1712

SPECIFICATION SHOWING AMENDMENTS

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WHAT IS CLAIMED IS:

1. (Amended) A wellbore fluid comprising a substantially water non-soluble particulate material that is degradable under acidic conditions and composed of the reaction product of A) one or more water soluble organic compound having possessing a molecular weight of less than 30,000 and possessing at least two hydroxyl groups and B) any other organic compound(s) capable of forming acetal or hemiacetal cross-links with the hydroxyl groups of compound A.
4. (Amended) The wellbore fluid according to any of the preceding claim, wherein 0.5-15%, dry weight of compound (BA) and 95.5-85% of said compound (AB) is reacted.
5. (Amended) The wellbore fluid according to ~~any of the preceding~~ claim 1 wherein the substantially water non-soluble particulate material is the reaction product of dextrin and pentanediol.
6. (Amended) ~~Application of the wellbore fluid according to any of the preceding claim as any of the following well processes:~~ A process of drilling, under-reaming, completing, working over, sealing loss zones, sealing fractures, sealing cavities or other very high permeability conduits in a rock formation, or hydraulic fracturing to stimulate a hydrocarbon-producing zone comprising using the fluid of claim 1.
7. (Amended) A ~~The process wherein after any of the well processes of claim 6~~ further comprising pumping; a low pH fluid containing any acid or buffered solution of less than pH 6.0 ~~is pumped~~ into the producing zone segment of the wellbore to catalyse the decomposition of the particulate material of this invention.
8. (Amended) ~~A process wherein, after any of the well processes in Claims 6 or 7,~~ The process of claims 6 or 7, further comprising allowing the well ~~is allowed to flow,~~ causing a drop in pH, which catalyses the decomposition of the substantially water non-soluble particulate material, solids of this invention permitting yet increased flow of produced fluids.

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